

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

REMARKS

The above-identified application has been carefully reviewed in light of the office action mailed April 17, 2006.

Without conceding to the correctness of the Examiner's rejections, claim 34 has been amended. Such amendments have been made seeking to obtain an early allowance in the above-identified application. Applicant expressly reserves the right to seek patent protection for the previous claims in the above-identified application, as well as any other claims supported by the above-identified application in one or more later filed applications.

Specifically, claim 34 has been amended to provide that the eye examination location includes a plurality of eye examination devices at the eye examination location. In addition, claim 34 has been amended to provide that the diagnostic center includes no eye examination devices. These amendments are fully supported by the present specification, for example, the drawings in the above-identified application and the description thereof.

Claims 34-38 and 41-46 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi et al. Claims 39-40 and 47-50 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi et al in view of Kennedy et al. Applicant traverses each of these rejections as it pertains to the present claims 34-50.

The present claims are directed to methods of conducting comprehensive eye examinations from a remote location. As understood by persons of ordinary skill in the art and as is apparent from the specification of the above-identified application, a comprehensive eye examination is an eye examination which permits a licensed eye care practitioner to

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

provide a diagnosis and a prescription, if necessary. This is in contrast to an eye screening which merely screens for the presence of an eye disorder.

The present methods for conducting comprehensive eye examinations comprise examining an eye of a patient at an eye examination location including a plurality of eye examination devices. The eye examination data is transported to a diagnostic center remotely located from the eye examination location to enable the diagnosis of an eye disorder or disease of the patient by a licensed eye care practitioner located at the diagnostic center. The diagnostic center includes no eye examination devices and, therefore, is different and distinct from the eye examination location which includes a plurality of eye examination devices. The present methods further comprise providing a diagnosis and a prescription, based on the eye examination data, to the patient via a communications link before the patient leaves the eye exam module.

As understood by persons of ordinary skill in the art, eye screenings and comprehensive eye examinations are different and distinct one from the other. For example, eye screenings provide instant results, such as photographs, of an eye to determine the presence of eye disorders. Eye screenings usually are conducted on large populations of people, and can result in relatively large numbers of false negatives and false positives. No physical contact is made with the patient in an eye screening, and no eye drops or medications are used. Thus, as understood by persons of ordinary skill in the art, eye screenings only seek to identify the presence of eye disorders and do not provide a diagnosis and a prescription to correct an eye disorder. In short, an eye screening provides a yes/no type

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

of answer (e.g., whether the patient has an eye disorder or not).

In contrast, a comprehensive eye examination includes an eye doctor or licensed eye care practitioner examining the inside of an eye to provide a diagnosis and prescription to correct an eye disorder, if necessary. Frequently, if not always, a comprehensive eye exam includes administration of topical eye drops to dilate the pupil of the eye. A comprehensive eye examination can be understood to include, for example, an assessment of a patient's history, general medical observations, external and ophthalmoscopic examinations, and visual acuity, ocular alignment and motility, refraction, and as appropriate, binocular vision or gross visual fields, tests, performed, for example, by an optometrist or an ophthalmologist, to obtain comprehensive eye exam data. Based on the obtained comprehensive eye exam data, the licensed eye care practitioner provide a diagnosis and a prescription to address an ophthalmic disorder or condition.

Thus, applicant submits that eye screenings and comprehensive eye exams are substantially different and distinct, one from the other.

Hosoi et al discloses a telecommunications system for examining an eye. In particular, the system disclosed by Hosoi et al includes a plurality of identical eye exam units (such as optician shops; see Fig. 1) in communication with each other such that an examiner can conduct an eye exam at one eye exam site of a patient located at a different eye exam site. Thus the examiner can operate the ophthalmic apparatus, that is the eye examination devices, while located at one of the identical eye exam units and perform an ophthalmic exam without being

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

present with the patient who is located at a different identical eye exam unit (column 1, lines 40-42).

Hosoi et al does not disclose, teach or even suggest the present invention. For example, Hosoi et al does not disclose, teach or even suggest examining an eye of a patient at an eye examination location using a plurality of eye examination devices at the eye examination location and transmitting the eye examination data to a diagnostic center remotely located from the eye examination location which diagnostic center includes no eye examination devices, as recited in the present claims. The fact that Hosoi et al discloses identical eye exam units and does not disclose, teach or even suggest a diagnostic center including no eye examination devices makes clear that Hosoi et al actually teaches clearly, directly and expressly away from the present invention.

In view of the above, applicant submits that the present claims, and in particular claims 34-38 and 42-46, are unobvious from and patentable over Hosoi et al under 35 U.S.C. 103(a).

Applicant submits that Kennedy does not supply the deficiencies apparent in the teachings of Hosoi et al.

Kennedy discloses a system and method for screening an eye. Thus, the system and method disclosed by Kennedy is expressly limited to eye screenings that only determine the presence of an eye disorder. This is in direct contrast to the methods recited in the present claims which are directed to comprehensive eye exams that include providing a diagnosis and prescription.

As discussed herein, it is well recognized that eye screenings and eye screening systems and methods such as the systems and methods disclosed by Kennedy et al are different and distinct from comprehensive eye exam systems and methods, as recited in the present claims. Thus, applicant submits that

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

Kennedy et al is directed to an entirely different and distinct problem than that addressed by the presently claimed invention.

Applicant submits that Hosoi et al and Kennedy et al, taken alone or any combination, do not disclose, teach or suggest the present invention. For example, as noted above, Hosoi et al, by teaching only identical eye exam sites actually teaches clearly, directly and expressly away from the present invention which includes an eye examination site and a differently structured diagnostic center, as recited in the present claims. Kennedy et al does not disclose, teach or even suggest a method of conducting a comprehensive eye exam, let alone in accordance with the present claims. As noted above, eye screenings such as conducted by Kennedy et al are different and distinct from comprehensive eye exams as recited in the present claims. Thus, applicant submits that the eye screenings of Kennedy et al actually teach away from the comprehensive eye exams of the present invention.

Importantly, the systems of Hosoi et al and Kennedy et al are so different and distinct, one from the other, that one of ordinary skill in the art is provided with no motivation or incentive to combine the teachings of these two references for any purpose, let alone for the purpose of obtaining the presently claimed methods. This is particularly true since both Hosoi et al and Kennedy et al teach away from the present invention.

Only after knowing of applicant's invention and disclosure would one of ordinary skill in the art even consider modifying and extending the deficient and mutually different teachings of Hosoi et al and Kennedy et al to obtain the methods recited in the present claims. Such hindsight reconstruction of the prior

Appl. No. 10/087,697
Reply to Office Action of April 17, 2006

art based on applicant's own invention and disclosure is an improper basis for rejecting patent claims.

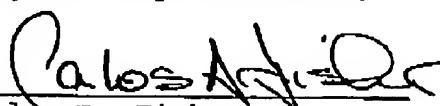
In view of the above, applicant submits that the present claims, and in particular claims 39-40 and 47-50, are unobvious from and patentable over Hosoi et al in view of Kennedy et al under 35 U.S.C. 103(a).

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art, taken singly or in any combination, disclose, teach or even suggest the present methods including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35 U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 34-50, are allowable and respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call applicant's attorney at the telephone number given below.

Respectfully submitted,

Date: 7/17/06


Carlos A. Fisher
Attorney for Applicant
Registration No. 36,510
4 Venture, Suite 300
Irvine, California 92618
(949) 450-1750
(949) 450-1764 Facsimile